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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,433	02/13/2004	Esther C. Fuhrman	103342-48580	8761
7590 11/14/2005			EXAMINER	
STEPHEN E. FELDMAN 12 EAST 41ST STREET SUITE 701 NEW YORK, NY 10017			REESE, DAVID C	
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DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/779,433	Applicant(s) FUHRMAN ET AL.	
	Examiner David C. Reese	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This office action is in response to Applicant's amendment filed 9/15/2005.

Status of Claims

- [1] Claims 1-17 are pending.

Drawings

- [2] The drawing(s) were previously objected for informalities. Applicant stated in the amendment filed 9/15/2005 that replacement drawing showing changes to Figure 5 were attached to this amendment. Such replacement drawings, however, were not found submitted with said amendment. Consequently, the objections to the drawings have not been withdrawn.

Specification

- [3] The disclosure was previously objected to for informalities. Applicant has successfully addressed these issues in the amendment filed on 9/15/2005. Accordingly, the objection(s) to the specification have been withdrawn.

Claim Objections

- [4] Claim(s) 1 were previously objected to because of informalities. Applicant has successfully addressed these issues in the amendment filed on 9/15/2005. Accordingly, the objection(s) to the claim(s) have been withdrawn.

Claim Rejections - 35 USC § 103

- [5] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[6] Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller, US-1,807,293, in view of Levy, US-5,008,984 and further in view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, Keller teaches of a jewelry fastener comprising a first housing (1), a second housing (11) having first (17) and second (11) external surfaces; a safety catch (6) having one end pivotally mounted to the first housing (5) and having a protuberance extending outwardly from the other end (7), the protuberance having a free end (end of 7), said second housing (11) having a slot (8) formed therein that passes fully through the second housing (11) to be accessible through both said first (8) and said second external surfaces (8'), said safety catch (6) being rotatable about the pivotal mounting (5) to a locked position wherein the free end (end of 7) of the protuberance (7) enters the slot (8) through either the first (8) or second external (8') surfaces of the second housing (11) to retain the first (1) and second (11) housings together (Fig. 2).

However, Keller fails to disclose expressly that each of the housing members contain a permanent magnet having a facing surface.

Levy teaches of a magnetic jewelry closure with clip that teaches of a first (28 of Levy) and second (4 of Levy) housing containing permanent magnets (8,6 of Levy) each having a

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facing surface, said permanent magnets (8,6 of Levy) both being magnetized so that the line of greatest magnetic force is perpendicular to the facing surfaces (Fig. 2 of Levy), said facing surfaces of the permanent magnets attracted to each other when positioned proximate to each other and within the field of the magnetic forces (Fig. 2 of Levy).

At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the jewelry fastener as taught by Keller, to incorporate magnets in each of its respective housing entities as taught by Levy, in order to provide additional securement to the clasp as well as to help the components of the clasp be brought together by in a more accurate, specific orientation, whereby the catch can then be properly inserted into the structure of the device. That is, as stated by Levy, in column 2 line 13, "The members join by magnetic attraction and the clip is closed to secure the closure". Continuing, "Due to the magnetic attraction between the members of the closure, the members seek each other and even if the user is infirm or disabled, the jewelry may be closed effortlessly. After joining the closure members together, the clip is closed and the closure members cannot be separated until the clip is released." In other words, the magnets aid in the combining the two houses or members of the closure, thereby allowing the clip or safety catch to secure the closure.

Re: Claim 2, wherein the first housing (1) has an opening and the permanent magnet in the second housing fits into the opening in the first housing to place the permanent magnets in close proximity to each other to magnetically attract each other (Keller in view of Levy, utilizing the teaching of magnets from Levy into that of the first and second housings of Keller to allow attraction between the two houses).

Re: Claim 3, wherein the safety catch has a straight member pivotally mounted to the first housing and the protuberance extends from the free end thereof at an angle of about 90 degrees (7 of Keller).

Re: Claim 4, wherein the slot has an outer surface having at least one indentation and said protuberance has at least one protruding nib that snaps into the at least one indentation when said safety catch is in said locked position to hold the first and second housings together (8 in Fig. 2 of Keller).

Re: Claim 5, wherein said at least one indentation is one indentation that is located about equidistant between each of the first and second external surfaces of the second housing (8 in Fig. 3 of Keller).

“About” is not indefinite in as much as its meaning is not broad and arbitrary; rather, term is clear and flexible and “approximately” or “nearly.” *Ex parte Eastwood Brindle & Knob* (PO BdApp) 163 USPQ 316.

Re: Claim 6, wherein the indentation is formed in a spring steel material (Note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material, therefore, in this case, it would have been readily apparent to one skilled in the art to use a spring steel material for the indentation so that the effect of snapping may be enhanced).

Re: Claim 7, wherein the safety catch has a magnetically attractable material or magnet that is attracted to the permanent magnet located in the second housing (Note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of

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its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material. Therefore, in this case, assuming that the device as presented by Keller is made of a metal, preferably steel, since as Keller states, "...fastener which will be simple, strong and durable construction..." Thus, due to such; steel is indeed a material that can be considered a "magnetically attractable material").

Re: Claim 8, wherein the magnetically attractable material comprises a magnet or steel plate affixed along an internal surface of said safety catch (see above).

Re: Claim 9, wherein the free end (end of 7) of the protuberance (7) extends beyond the depth of the slot (col. 2, line 70, "...keeper 7, which when the parts are in locked position is adapted to pass through the pair of openings 8...") thereby allowing the free end of the protuberance (end of 7) to protrude from the jewelry clasp. Further, with respect to the length of the protuberance and/or free end of said protuberance, it is pertinent to point out that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between

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the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

As for Claim 10, Keller in view of Levy teach of a method of completing the connection of a jewelry clasp comprising the steps of:

providing a first housing having a jewelry chain affixed thereto (12 in Keller), a pair of oppositely disposed external surfaces and having magnetic surface (Keller in view of Levy),

providing a second housing having a jewelry chain affixed thereto and having a magnetic surface (2 in Keller);

joining the first (1) and second (11) housings together by aligning and facing the magnetic surfaces facing each other (Keller in view of Levy);

providing a safety catch (6) movable affixed to the second housing and adapted to be movable to a locked position (Fig. 2); said safety catch having a free end (end of 7);

providing a slot (8, 8' in Fig. 2) in the first housing that extends entirely through the housing and opening through both of said oppositely disposed external surfaces (8, 8' in Fig. 2);

engaging the first (1) and second (11) housings together to align the magnetic surface of the first housing with the magnetic surface of the second housing abutted together to complete the connection of the first and second housings together (Keller in view of Levy); and

moving the safety catch to the locked position wherein the free end (end of 7) of the safety catch enters into the slot through the opening in either of the oppositely disposed external surfaces (7 into 8, 8' Fig. 2).

Re: Claim 11, wherein the step of providing a first housing and the step of providing a second housing comprises providing a first housing and a second housing having permanent magnets disposed therein forming the magnetic surfaces (Keller in view of utilizing the teaching of magnets from Levy).

Re: Claim 12, wherein the step of providing a safety catch comprises providing a safety catch (6) having a nib extending outwardly therefrom (8 in Fig. 2) and said step of providing a slot comprises providing a slot (8 in Fig. 2) having an indentation formed therein and said step of moving the safety catch to a locked position comprises engaging the nib within the indentation (7 into 8 in Fig. 2 of Keller).

Re: Claim 13, wherein the step of providing a safety catch comprises providing a safety catch having a magnet or magnetically attractable material that is attracted to the permanent magnet located in the second housing (Note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material. Therefore, in this case, assuming that the device as presented by Keller is made of a metal, preferably steel, since as Keller states, "...fastener which will be simple, strong and durable construction..." Thus, due to such; steel is indeed a material that can be considered a "magnetically attractable material").

Re: Claim 14, wherein the step of providing a safety catch comprises providing a safety catch (6) having a nib extending outwardly therefrom (8 in Fig. 2) and said step of moving the safety catch to a locked position comprises moving the safety catch to a position where the

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magnetically attractable material is attracted to the permanent magnet in said second housing (Keller in view of Levy, also; see Claim 13 rejection).

Re: Claim 15, wherein the step of providing a safety catch comprises providing a safety catch (6) having a magnetically attractable material (Claim 13) located on a surface that overlies one of the oppositely disposed external surfaces of the second housing (15 and above in Fig. 2).

Re: Claim 16, wherein the step of providing a safety catch comprises providing a safety catch (6) having the magnet or magnetically attractable material (Claim 13) located on a surface that abuts against an internal surface of the slot formed in the second housing (7 into 8 in Fig. 2).

Re: Claim 17, wherein the step of moving the catch (6) to the locked position allows the free end (end of 7) of the protuberance to extend beyond the depth of the slot (col. 2, line 70, "...keeper 7, which when the parts are in locked position is adapted to pass through the pair of openings 8...") thereby allowing the free end of the protuberance (end of 7) to protrude from the jewelry clasp. Further, with respect to the length of the protuberance and/or free end of said protuberance, it is pertinent to point out that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a

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recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Response to Arguments

[7] Applicant's arguments filed 9/15/2005 regarding rejections under 35 U.S.C. 103 are considered moot to the new application of the prior art to applicant's instant amendment of said claims.

Conclusion

[8] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

[9] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272- 7082. The examiner can normally be reached on 7:30 am - 6:00 pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. **Please also note the change in the fax phone number to (571) 273-8300 for the organization where this application or proceeding is assigned.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DCR


ROBERT J. SANDY
PRIMARY EXAMINER

Sincerely,
David Reese
Assistant Examiner
Art Unit 3677